

Claims 52-63

The claims in this group recite the feature of storing “*audio information* associated with the caller identification data” (independent claim 52), “*audio identity information* associated with the caller identification data” (independent claim 57), and “*audio information* associated with the non-voice alphanumeric information” (independent claim 62). These claims and their respective dependent claims stand rejected as anticipated by or obvious over Lim (U.S. Patent No. 5,265,145). With regard to obviousness, the Examiner does not purport to find the “audio information” claim feature in the secondary reference, Figa (U.S. Patent No. 4,924,496), and so the consideration of this rejection turns entirely on the teachings of Lim.

Applicant maintains the position that Lim only discloses the storage and retrieval of digital text information, not audio information, and thus does not anticipate or render obvious any of these claims.

In the Action, the Examiner at page 11 evidently agrees with Applicant’s position that the “speech synthesizer” in Lim uses stored digital text information, not audio information, to produce an audio announcement.

However, the Examiner’s position at page 11 of the Action is that the “voice recording/reproducing unit *inherently defines itself as an audio recording unit* as one having skilled in the art could recognize.” (Emphasis added.) The Examiner’s invalidity argument thus turns on principles of inherency, and Applicant respectfully submits that the Examiner has not made a sufficient showing of inherency to sustain the rejection of these claims.

In making a rejection based on prior art, it is the Examiner’s burden to make out a *prima facie* case of invalidity under either 35 U.S.C. §§ 102 or 103. *See, e.g.,* MPEP § 706 (“The

burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter.”)

Where an Examiner’s rejection is based on a feature alleged to be inherent in the prior art, the Examiner must establish that the allegedly inherent feature *necessarily flows from the prior art*. As the Board has stated: “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also MPEP 2112, which states in part:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

Thus, the Examiner must demonstrate that his conclusion—that “voice recorder/reproducer IC” in Lim employs audio information—“necessarily flows from the teachings of’ Lim. Applicant respectfully submits that the Examiner has not met his burden in this regard, and has not made the showing required to rely on principles of inherency. The disclosure in Lim is simply too vague and ambiguous to support the Examiner’s conclusions

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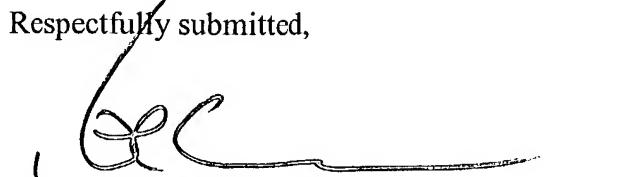
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regarding the precise characteristics of the recorder/reproducer IC, and whether it inherently employs audio information. Applicant submits that Lim contemplates only the storage of digital text information (a view that is further supported by the Examiner's apparent agreement that the "speech synthesizer" in Lim uses stored digital text information), not audio information, and thus does not anticipate or render obvious any of claims 52-63. In view of this, Applicant respectfully submits that the rejections of claims 52-63 over Lim are thus traversed.

For the foregoing reasons, Applicant submits that all of the pending claims are allowable, which action is requested.

A Petition for Extension of Time is enclosed herewith, together with a check for the required fee. Please apply any other charges, or make any credits, to Deposit Account No. 06-1050, reference 10200-007002.

Respectfully submitted,

  
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